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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,662	09/30/2003	Truc Nguyen	66329/00008	5004

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EXAMINER	
HANG, VU B	

ART UNIT	PAPER NUMBER
2625	

NOTIFICATION DATE	DELIVERY MODE
07/23/2009	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patents@tuckerellis.com

Office Action Summary	Application No.	Applicant(s)	
	10/674,662	NGUYEN ET AL.	
	Examiner	Art Unit	
	Vu B. Hang	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *31 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,5-7,9 and 11* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3,5-7,9 and 11* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *30 September 2003* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

- This office action is responsive to the communication filed on 03/31/2009.
- The amendments received on 03/31/2009 have been entered and made of record.
- Claims 1, 3, 5-7, 9 and 11 are pending in the current application.

Response to Arguments

1. Applicant's arguments filed on 03/31/2009, with respect to the cited prior art Ferlitsch (US Pub. 2004/0184105) and the submitted affidavit uder 37 CFR 1.131, have been fully considered and are persuasive. Therefore, the previous rejections of Claims 1, 3, 5-7, 9 and 11 have been withdrawn. However, upon further consideration, a new ground of rejection is made in view of Kimber et al. (US Patent 5,903,716).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3, 5-7, 9 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hansen et al. (US Patent 6,407,820 B1) in view of Bhogal et al. (US Patent 7,088,462), and in further view of Kimber et al. (US Patent 5,903,716).

4. Regarding **Claim 1**, Hansen discloses a system for priming electronic files (see Fig. 1 and Col.4, Line 4-13), comprising: a means adapted for receiving an electronic file, wherein the

electronic file is representative of a document (see Fig. 1 (102) and Col.4, Line 4-13); a means adapted for receiving a print instruction via an application associated with the electronic file (see Fig.1 (102), Col.4, Line 4-13 and Col.4, Line 51-67); a means adapted for enabling a print driver corresponding to at least one associated document output device in accordance with a received print instruction (see Fig. 1 (110,120), Fig.3 and Col.5, Line 45-60); a means adapted for prompting a user, via an application and print driver, for print setting information corresponding to the electronic file, the print setting information including stapling, hole punching, output destination, collating and finishing (see Fig. 1 (116,120), Fig.4 (406,408), Col.9, Line 52-60, Col. 11, Line 57-67 and Col. 15, Line 37-43); a means adapted for generating printer finishing configuration setting data (see Fig. 1 (106,108), Col.3, Line 66 - Col.4, Line 2 and Col.9, Line 52-60); a means adapted for automatically storing the generated printer configuration setting information data in a storage of the document output device (see Fig. 1 (118,120), Col.6, Line 26- 33 and Col.6,Line 46-50) [Note: the configuration setting information is stored at the document output devices through the printer server when a print job is executed.]; an association means for associatively storing the printer finishing configuration setting information data with the electronic file such that the subsequent recall of the electronic file automatically retrieves print setting information data associated therewith (see Fig.4 (302), Col. 10, Line 17-24 and Col. 12, Line 39- 61); a conversion means for converting the electronic file into an image file (see Fig.4 (320) and Col.5, Line 22-25); a means adapted for creating a print job in accordance with the image file and the printer finishing configuration setting information data (see Fig.4 (320), Col.9, Line 23-39 and Col.9, Line 52-60) a means adapted for receiving data representative of a user request to select the print job for output to at least one selected destination, including a

printed copy of the documents and an electronic copy of the image file (see Fig. 1 (106, 108,110120), Col.7, Line 25-40 and Col.9, Line 52-60); a means for retrieving, from the associated storage, the print setting information data corresponding to the electronic file in accordance with a received output request data (see Fig. 1 (106, 108,110120), Col.7, Line 25-40 and Col.9, Line 52-60); and a means for displaying a list of previously printed documents (see Fig.4 (302), Fig.5 and Col.15, Line 31-58). [Note: Figure 5 shows a user interface displayed at the workstation for restoring and viewing the previously saved/processed print job tickets.]

5. Hansen fails to expressly disclose a means for receiving a primary and secondary output request data; and a means for outputting a first copy of the image file in accordance with primary output request data or the second copy of the image file in accordance with secondary output request data. Hansen also fails to disclose a means for appending the printer configuration setting information data to the electronic file as printer job language commands and communicating the electronic file and the printer job language to the document output device. Hansen, however, discloses a means for creating standardized tickets to be stored (Col. 10, Line 17-24); and teaches restoring and updating the stored print tickets for reprinting (see Col.9, Line 52-60 and Col. 10, Line 17-24). Bhogal discloses a means for receiving primary and secondary output request data for routing the print jobs to the appropriate printers, based on the received print job information (see Fig.4 (400,408,410), Fig.5 and Col.6, Line 50- 67); a means for retrieving, from the associated storage, the print setting information data corresponding to the electronic file in accordance with a received output request data (see Fig.4 (412,418), Fig.5 and Col.6, Line 50 - Col.7, Line 8); and a means for outputting a first copy of the image file in accordance with the primary output request data or the second copy of the image file in accordance with secondary

output request data (see Fig.4 (408,410), Fig.5 and Col.6, Line 50 - Col.7, Line 8). Kimber teaches a virtual printer driver system wherein information relating to printer configuration is attached to a print job (see Fig.1 (12,16,22), Fig.3, abstract, Col.2, Line 5-27 and Col.5, Line 40-49), and the print job and the attached configuration information is sent to a network printer for printer configuration and print job execution (see Fig.1 (12,16,22), Col.4, Line 28-30 and Col.5, Line 40-49). Kimber further teaches processing the printer configuration and print job data as printer job language commands (see Fig.2 (16,24,26), Fig.4 (30,34,36,38) and Col.5, Line 20-30).

6. Hansen, Bhogal and Kimber are combinable because they are from the same field of endeavor, namely print data processing systems. At the time of the invention, it would have been obvious for one skilled in the art to include to Hansen's system, a means for receiving a primary and secondary output request data; and a means for outputting a first copy of the image file in accordance with primary output request data or the second copy of the image file in accordance with secondary output request data. The motivation would be to increase the flexibility for the print system in terms of creating customized print settings and default print settings. This would ensure that a print setting is in place when specific print job features are not specified. The modified print system would also enable a user to restore and update existing print settings that were previously stored for reprinting. It is further obvious for one skilled in the art to include a means for appending the printer configuration setting information data to a print job as printer job language commands, and communicating the print job and the printer job language to the document output device. The motivation would be to provide a virtual printer driver system for dynamically configuring an output device in accordance to the specification of a print job. This

would enable for an output device to be automatically configured to carry out the execution of a specific print job.

7. Regarding **Claim 3**, Hansen further discloses at least one command is in a printer job language format (see Col.4, Line 61 - Col.5, Line 5 and Col.5, Line 47-64).

8. Regarding **Claim 5**, Hansen further discloses a storage means adapted for storing the print jobs (see Fig.1 (118) and Col.6, Line 23-33).

9. Regarding **Claim 6**, the rationale provided for the rejection of Claim 1 is incorporated herein.

10. Regarding **Claims 7, 9 and 11**, the claims recite claim limitations that are similar and in the same scope of invention as to those in Claims 1, 3 and 6 above and/or in combination thereof. Therefore, Claims 7, 9 and 11 are rejected for the same rejection rationale/basis as described in Claims 1, 3 and 6 respectively.

Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vu B. Hang whose telephone number is (571)272-0582. The examiner can normally be reached on Monday-Friday, 9:00am - 6:00pm.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vu B. Hang/
Examiner, Art Unit 2625

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625